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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	450100-03088	4221
20999	7590	06/29/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/819,965

Applicant(s)

YOSHIMINE ET AL.

Examiner

Donald L. Champagne

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M6

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Also, material critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). At each independent claim 1, 7 and 13, there is a limitation to "providing said content with advertisement information to said client" (e.g., at claim 1 lines 5-6, with emphasis added). The only client mentioned before this limitation is "an advertisement client" (e.g., at claim 1 line 4). The specification does not describe providing said content with advertisement information to an advertisement client.
3. Also, claim 13 (line 4) is limited to "advertisement information supplied by a content client" (emphasis added). The specification does not describe advertisement information supplied by a content client.
4. In general, the claims are confusing because "client" is used, with or without proper modification, to mean providers of either content or advertising, or users of the invention.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 19-24 and 27, 30, 33 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At claim 19, line 10, "said client" is indefinite. At the last line of each claim 27, 30, 33 and 36, "head portion said advertisement information" is indefinite.

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being obvious over Landsman et al. (US006314451B1) in view of Sterne.
9. Landsman et al. teaches (independent claims 1, 7, 13, 19, 25, 28, 31 and 34) a device, method, program storage medium and system for profit-giveback and providing content, the method comprising: storing a content with *advertising tag 40*, which reads on advertisement information, and providing said content with advertising information to a client (col. 17 lines 39-43); and performing profit give-back processing (col. 13 lines 51-54).
10. Landsman et al. does not teach that said performing profit give-back processing is proportionate to the number of times that said content with advertising information is provided to said client. Sterne (p. 25) teaches that the benefit received by advertisers is proportional to the number of times that said content with advertising information is provided to said client. Because this rule maximizes benefits to the advertisers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Sterne to those of Landsman et al.
11. For independent claims 25, 28, 31 and 34, Landsman et al. teaches an agent that decides whether or not to deliver an ad to *advertising tag 40* (col. 9 line 64 to col. 10 line 12), said agent reading on control means for providing said client with either said content or said content with advertisement information.
12. For all the claims, any monetary units (e.g., dollars) used for profit sharing reads on "points". All accounting, including said profit sharing, is commonly done in units of money. Said profit sharing in units of money gives the recipient (content supplier) a right to online shopping and it is cash given back (claims 4-5, 10-11, 16-17 and 22-23).

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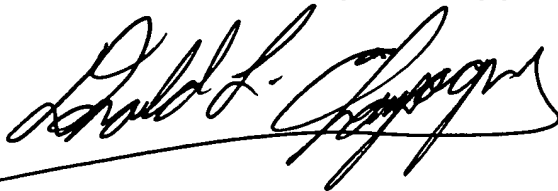
13. Concerning dependent claims 2-3, 8-9, 14-15 and 20-21, neither of the references teach giving back part of the advertisement charges, and basing this give-back on the connection charges and service use charges paid by the advertiser. These method of computing profit give back would be obvious for the following reasons. Profit is the difference between revenues and costs. The primary source of revenue is advertising charges, so profit giveback is giving back part of the advertisement charges minus the advertiser's cost. These costs include the connection charges and service use charges paid by the advertiser.
14. Concerning dependent claims 6, 12, 18, 24, 27, 30, 33 and 36, neither of the references teaches appending said advertisement information to the head portion of said content. Landsman et al. teaches that the location of the *advertising tag 40* is functionally unimportant (col. 17 lines 43-46). Because it is a convenient place to put the tag, making it easy to find, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add appending said advertisement information to the head portion of said content to the teachings of Landsman et al.
15. Landsman et al. teaches claims 26, 29, 32 and 35 as the user's PC display an browser.

### **Conclusion**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
17. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring

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that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

A handwritten signature in black ink, appearing to read "Donald L. Champagne", written over a horizontal line.

Donald L. Champagne  
Examiner  
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26 June 2004